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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/761,351 | 01/22/2004 | Craig Ullman | 559442600207 | 3432 |
| 43997 | 7590 | 03/21/2006 | EXAMINER | |
| OPTV/MOFO C/O MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD, SUITE 300 MCLEAN, VA 22102 | | | VU, VIET DUY | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2154 | |

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/761,351

Applicant(s)

ULLMAN ET AL.

Examiner

Viet Vu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 8, 11, 24, 30, 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169, 171-174, 181-183 and 187-189 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12/05</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are
1,2,4,8,11,24,30,57,64,67,80,86,87,113,114,116,120,123,136,142,143,169,171-174,181-183 and 187-189.

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Art Rejections:

1. The text of 35 U.S.C. § 102(e) cited in the previous office action are hereby incorporated by reference.

2. Claims 1-2, 4, 8, 11, 24, 30, 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169, 171-174, 181-183 and 187-189 are rejected under 35 U.S.C. § 103(a) as being clearly anticipated by Throckmorton et al, U.S. pat. No. 5,818,441.

Per claims 1, 8 and 11, Throckmorton discloses a system and method for providing broadcast programs and online contents to users comprising:

a) an encoder for encoding associated data, the program and time code for controlling when the associated data can be retrieved (from a local storage or the network), into program signal (see col 4, lines 52-65; col 5, lines 48-64 and col 7, lines 21-52), wherein the associated data comprising online content and/or network address for retrieving online content (see col 9, lines 15-25);

b) a transmitter (30, fig. 2) for transmitting the programming signal to a remote user via a transmission medium (see col 5, line 65 - col 6, line 3);

c) a network interface program, responsive to user's request, for automatically using the encoded address to retrieve and play

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online content to the user in conjunction with the program (see col 7, lines 36-45).

Per claim 2, Throckmorton teaches implementing the broadcast content and associated data at the same site, i.e., production distribution site, web hosting site, etc., (see col 3, lines 45-67).

Per claim 4, Throckmorton teaches delivering the program on a recording medium, e.g., cassettes, CDs (see col 3, lines 36-42).

Per claim 24, Throckmorton teaches embedding the associated data including the address in a non-presented portion of the program (see col 5, lines 56-59).

Per claim 30, Throckmorton teaches that program signal can be in analog or digital formats (see col 4, lines 34-39).

Claims 57, 64, 67, 80, 86-87, 113-114, 116, 120, 123, 136, 142-143, 169, 171-174, 181-183 and 187-189 are similar in scope as that of claims 1-2, 4, 8, 11, 24 and 30 and hence are rejected for the same rationale set forth above.

Response to Amendment:

3. Applicant's arguments filed on 1/30/06 have been considered but are moot in view of new ground of rejection set forth above.

Applicant asserts that the applied art of record fails to teach a timing indicia that controls when the embedded online address is used to retrieve online content.

The examiner disagrees with applicant's alleged reading of the present claims to include a limitation of using timing indicia and address to control when to retrieve online content. Particularly, the examiner is unable to find claim limitation, i.e., specific means or step, for controlling the retrieval of online content from the network. It should be clear from the specification that the timing indicia only contain time codes while the address contains network address. Neither the address nor timing indicia themselves can perform the function of retrieving the online content from the network. As such, the present claims can only be construed to indicate purpose and intended use of the timing indicia and address.

As set forth above, the newly applied art of record, Throckmorton teaches using embedded time code in the program signal to control when online content and address can be retrieved and displayed in conjunction with the program (see col 4, lines 52-65; col 5, lines 48-64 and col 7, lines 21-52). Throckmorton also teaches that the address can be further used to retrieve other online content from the network (see col 7,

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lines 36-45). Thus, both purpose and intended use of the claimed time code and address are clearly disclosed by Throckmorton.

Conclusion:

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Thursday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIET D. VU
PRIMARY EXAMINER

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3/17/06